UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	020748.0104PTUS	9954

32042	7590	10/07/2004

PATTON BOGGS LLP
8484 WESTPARK DRIVE
SUITE 900
MCLEAN, VA 22102

EXAMINER
GART, MATTHEW S

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2004*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-2 and 4-9* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-2 and 4-9 are pending in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4 and 7-9 are rejected under 35 U.S.C. 102(e) as being

anticipated by Mashinsky (U.S. Patent No. 6,226,365 B1).

Referring to claim 1. Mashinsky discloses a computer-implemented method for

distributing telecommunication services, the method comprising:

- Storing in memory a set of responses to purchase requests for

  telecommunication services associated with a plurality of service providers

  (Mashinsky: column 2, lines 33-50, "Service requestors submit service requests

  to the centralized server node."), each response reflecting at least one

  telecommunication service offering associated with one of the service providers

  and a related cost for the telecommunication service offering (Mashinsky: column

  9, lines 22-33, "In step 3, server node **56** derives rate-tables from the collected

rate information which list the cost of connecting any two locations within the telecommunication node network via various routes...");

- Establishing a session over a network for considering the purchase of telecommunication services (Mashinsky: column 11, lines 31-55, "Purchase Request");

- Receiving a purchase request at a computer on the network including information indicating a requested telecommunication service (Mashinsky: column 11, lines 31-55, "Purchase Request");

- Assessing the stored set of responses to purchase requests for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service (Mashinsky: column 2, lines 33-57); and

- Preventing a requester from accepting the response after the session is terminated (Mashinsky: column 13, lines 29-31).

In the method described by Mashinsky, the customer may conveniently purchase connection time on one of the displayed routes by clicking on the displayed information. In that event, the system directly prompts the customer with a template or other graphical interface to permit the user to enter the amount of time to be bought or sold, the asking price, etc. If the transaction criteria cannot be completely filled at the requested rate, the server node cancels the transaction; therefore the requestor is no longer able to accept the response because the session is terminated (column 13, lines 29-31). In the method as described by Mashinsky the negotiations is done in real-time

with actual market prices. These market prices are fluctuating continuously, once an

request is made and denied by the service provider, the request is cleared from the

negotiation table, and a new session would begin.

Referring to claim 2. Mashinsky further discloses a method comprising

terminating the session, such that when the session is terminated the responses can no

longer be accepted (Mashinsky: column 13, lines 15-39).

Referring to claim 4. Mashinsky further discloses a method comprising

permitting access by service providers to the stored set of responses to purchase for

telecommunication services (Mashinsky: column 12, lines 54-61).

Referring to claim 7. Mashinsky further discloses a method permitting each

service provider to modify the stored set of responses to requests for

telecommunications services to reflect changes in the service providers

telecommunication service offering (Mashinsky: column 18, lines 3-34).

Referring to claims 8 and 9. Claims 8 and 9 are rejected under the same

rationale as set forth above in claims 1-2 and 4-7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mashinsky (U.S. Patent No. 6,226,365 B1) in view of Ojha (U.S. Patent No.

6,598,026 B1).

Referring to claims 5 and 6. Mashinsky discloses a telecommunication system

and method according to claim 1 as indicated supra. Mashinsky does not expressly

discloses a system and method comprising denying access by the service providers to

the stored set of responses to purchase request for telecommunication service during

the session, wherein the response to which access is denied is the same as the

response reflecting at least one telecommunication service offering capable of satisfying

the requested telecommunication service. The instant invention defines a session as a

point in time for considering an offer (page 3 of the instant application as filed). Ojma

discloses a system and method comprising denying access by the service providers to

the stored set of responses to purchase request for telecommunication service during

the session, wherein the response to which access is denied is the same as the

response reflecting at least one telecommunication service offering capable of satisfying

the requested telecommunication service. The seller of Ojma may authorize automated

responses to bids by specifying a number of business rules to govern responses.

According to Ojma, any number of business rules may be defined by the seller and may be executed in any sequence specified by the seller. For each rule, the seller defines a set of criteria and a set of actions to be taken when the set of criteria is satisfied. Any number of criteria may be defined and combined in a variety of ways using logical operators (e.g., AND, OR, NOT) and groupings. Examples of criteria include (but are not limited to) bid-list spread, product type or group, the number of units, the buyer's reputation, etc. Similarly, any number of actions may be specified. Examples of actions includes (but are not limited to) text responses, ask price reductions, bid acceptance, etc. (Ojma: col. 15, line 31 to col.16, line 4). Once the business rules are stored (Ojma: Fig. 13c) and a buyer makes an offer to the seller, in both the instant invention and Ojma, the rules are automatically implemented on behalf of the seller. The seller would no longer have access or the opportunity to change those rules during the particular negotiation session, wherein as practiced in Ojma the session is practically instantaneous.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Mashinsky to have included the limitations of Ojma as discussed above because there is a demand for technical solutions by which electronic commerce transactions may be facilitated and made more efficient, furthermore it is understood that the ability to identify prices for any two parties in an efficient manner would be of potentially great value to both buyers and sellers (Ojma: col. 2, lines 10-25).

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 7-9 filed 9/13/2004 have been fully considered but they are not persuasive.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Attorney argues that Mashinsky actually teaches away from the recited elements of Claims 5 and 6.

The Examiner notes, the method and system of Ojma in combination with Mashinsky does not render Mashinsky unsatisfactory for its intended purpose, i.e. flexibly routing communications transmissions in an efficient manner. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, at the time the invention was

made, it would have been obvious to a person of ordinary skill in the art to have

modified the system of Mashinsky to have included the limitations of Ojma as discussed

above because there is a demand for technical solutions by which electronic commerce

transactions may be facilitated and made more efficient, furthermore it is understood

that the ability to identify prices for any two parties in an efficient manner would be of

potentially great value to both buyers and sellers (Ojma: col. 2, lines 10-25).

The Attorney argues that Ojha does not disclose, teach or suggest the recited

denial of access to a service provider during a purchasing session included in claims 5

and 6.

The Examiner notes, as mentioned above, Ojha does disclose a system and

method comprising denying access by the service providers to the stored set of

responses to purchase request for telecommunication service during the session,

wherein the response to which access is denied is the same as the response reflecting

at least one telecommunication service offering capable of satisfying the requested

telecommunication service. The seller of Ojma may authorize automated responses to

bids by specifying a number of business rules to govern responses. According to Ojma,

any number of business rules may be defined by the seller and may be executed in any

sequence specified by the seller. Once the business rules are stored (Ojma: Fig. 13c)

and a buyer makes an offer to the seller, in both the instant invention and Ojma, the rules are automatically implemented on behalf of the seller. The seller would no longer have access or the opportunity to change those rules during the particular negotiation session, wherein as practiced in Ojma the session is practically instantaneous.

The Attorney argues that the rules can still be changed in Ojha by a seller and there is no teaching in Ojha of limiting such changes or the time of such changes.

The Examiner reiterates, the seller would no longer have access or the opportunity to change those rules during the particular negotiation session, wherein as practiced in Ojma the session is practically instantaneous. Once an offer by the seller is initiated the business rules as set are applied automatically, thus limiting the opportunity to change or modify the stored set of responses.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
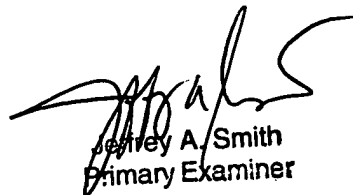
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG
Patent Examiner
September 29, 2004

Jeffrey A. Smith
Primary Examiner